

REMARKS

A final Official Action has been received and its contents carefully noted (Paper No. 20080516). This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Filed concurrently herewith is a *Request for Continued Examination*. Accordingly, the Applicant respectfully submits that this response is being timely filed.

Claims 27-52 were pending in the present application prior to the above amendment. Claims 29, 30 and 37 have been canceled without prejudice or disclaimer. Claims 27, 28, 31-33, 35, 36, 38-41 and 43-49 have been amended to better recite the features of the present invention. Accordingly, claims 27, 28, 31-36 and 38-52 are currently pending, of which claims 27, 48 and 50 are independent. Although the Office Action Summary excludes claims 50-52 from the list of pending and rejected claims, the Applicant notes that in the *Amendment* filed on February 19, 2008, claims 50-52 were merely withdrawn, not canceled. Claims 50-52 have been withdrawn from consideration by the Examiner (Box 4a, Office Action Summary, Paper No. 20071108). Accordingly, claims 27, 28, 31-36 and 38-49 are currently elected, of which claims 27 and 48 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claim 27 under 35 U.S.C. § 112, second paragraph, asserting that the claims are "indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention" (page 2, Paper No. 20080516). Specifically, the Official Action asserts that claim 27 "does not recite who or how the sending party is identified," that "it is unclear how ... the sending party [is] considered 'an identified party'" and that "it [is] unclear what is considered 'identified sender's associated advertisement'" (*Id.*).

In response, the Applicant has amended claim 27 to more clearly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 27 has been amended to recite a method of automatically transmitting an

advertisement for hardware installed on a data processing system, the advertisement being associated with an identified sending party and transmitted from the identified sending party to a receiving party comprising the steps of: identifying a user of the data processing system, said identified user being the identified sending party; initiating an e-mail communication from the data processing system of the identified sending party; embedding at least one pre-selected advertisement associated with the identified sending party, said embedding being done within the data processing system of the identified sending party; and transmitting the e-mail communication with the at least one advertisement associated with the identified sending party automatically embedded therein by the data processing system of the identified sending party to the receiving party, wherein said advertisement is for hardware installed on the data processing system by said identified sending party.

In the amended claim, it is clear that the method includes a step of identifying a user of a data processing system, and that the identified user is the identified sending party. These concepts are supported in the present specification. For example, the present specification makes clear that the sender may be "personally known by the recipient." Also, the recipient may be "made aware that the sender (or chain of senders) of the communication uses, supports, or otherwise advocates the product or service being advertised." The communication may be "an intended communication from a sender to a recipient," not merely a SPAM message. That is, the communication may be a personal communication from a sender who is "personally known" to the recipient and not mere SPAM. The e-mail message may "include a personal or business related message wholly separate from any advertisement contained therein."

Also, in the "Response to Arguments" section, the Official Action asserts that "there is no indication of where the embedding is done" (page 7, *Id.*). As noted in detail above, claim 27 has been amended by changing "associating" to "embedding" and to further recite "said embedding being done within the data processing system of the

identified sending party." As such, amended claim 27 is clear as to where the embedding is done.

The Applicant respectfully submits that amended claim 27, when read in light of the present specification, particularly points out and distinctly claims the subject matter which applicant regards as the invention and is definite. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 112 are in order and respectfully requested.

The Official Action rejects claims 27, 28, 30-35 and 37-43 as anticipated by U.S. Patent No. 5,513,254 to Markowitz. The Applicant respectfully submits that an anticipation rejection cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent claim 27 has been amended as noted in detail above. In summary, amended claim 27 recites (1) advertisement for hardware installed on a data processing system by an identified sending party; (2) an e-mail communication; (3) that embedding takes place within the data processing system of the identified sending party; and (4) identifying a user of the data processing system, the identified user being the identified sending party.

Also, dependent claims 28, 34, 38 and 39 have been amended to clarify that in the step of offering to the user an option of becoming an advertiser, the user is the user of the data processing system. Using the present invention according to claims 28, 34, 38 and 39, a user can, for example, purchase a peripheral, such as a mouse, manufactured by a given manufacturer. After installation of the peripheral in the user's computer, the user may be given an option to become an advertiser for the peripheral and/or manufacturer. After agreeing to become an advertiser, e-mail messages sent by

the user will include an advertisement, which may include a personalized message. The user may be provided with compensation or some desirable functionality in exchange for becoming an advertiser. For example, a user can add a mouse to a computer. Thereafter, in accordance with the present invention, advertisements for any given brand appear in the user's communications and the recipient knows, by way of the terms and method, that the advertisement is associated specifically with the user.

For the reasons provided below, the Applicant respectfully submits that Markowitz does not teach the above-referenced features of the present invention, either explicitly or inherently.

Markowitz does not teach, either explicitly or inherently, a method of automatically transmitting an advertisement for hardware installed on a data processing system, the advertisement being associated with an identified sending party and transmitted from the identified sending party to a receiving party. Rather, Markowitz appears to teach the following: "In accordance with an aspect of the invention, the particular advertisements being incorporated with the user's facsimile information are independent of the content of the user's facsimile information" (column 1, lines 59-62; emphasis added). As such, in Markowitz, the advertisement is not associated with an identified sending party, and the advertisement is not for hardware installed on the data processing system.

Also, Markowitz does not teach, either explicitly or inherently, identifying a user of the data processing system, said identified user being the identified sending party; initiating an e-mail communication from the data processing system of the identified sending party; embedding at least one pre-selected advertisement associated with the identified sending party, said embedding being done within the data processing system of the identified sending party; and transmitting the e-mail communication with the at least one advertisement associated with the identified sending party automatically embedded therein by the data processing system of the identified sending party to the

receiving party, wherein said advertisement is for hardware installed on the data processing system by said identified sending party.

Therefore, the Applicant respectfully submits that Markowitz does not teach the above-referenced features of amended claim 27, either explicitly or inherently.

Also, regarding dependent claims 28, 34, 38 and 39, the Official Action asserts that "Markowitz teaches offering to a user an option of becoming an advertiser ... (see col. 2 lines 35-56, col. 4 lines 22-36)" (page 3, Paper No. 20080516; see also page 8). The Applicant respectfully disagrees and traverses the assertions in the Official Action. Markowitz does not teach, either explicitly or inherently, offering to the user of the data processing system an option of becoming an advertiser.

Since Markowitz does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

The Official Action rejects claims 27 and 46 as anticipated by U.S. Patent No. 5,937,037 to Kamel. The Applicant respectfully submits that an anticipation rejection cannot be maintained against the claims of the present application, as amended.

Independent claim 27 has been amended as noted in detail above. Dependent claim 46 has been amended to clarify that automatically embedding the at least one pre-selected advertisement associated with the identified sending party with the e-mail communication further comprises automatically embedding a personal testimonial by the sending party thereby lending credibility to the at least one advertisement associated with the identified sending party. The Applicant respectfully submits that Kamel does not teach the above-referenced features of the present invention, either explicitly or inherently.

Since Kamel does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly,

reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

The Official Action rejects dependent claims 29, 44 and 45 as obvious based on Markowitz. The Applicant respectfully submits that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Please incorporate the arguments above with respect to the deficiencies in Markowitz. The Official Action concedes that "Markowitz does not explicitly disclose wherein the at least one advertisement (identified sender's associated advertisement) is related to at least one of software or hardware operable with the data processing system" (page 5, Paper No. 20080516). The Official Action asserts that "[i]t would have been obvious to one of ordinary skill in the art ... to know that any advertisement, including advertisement about software or hardware could be included in Markowitz's

system” (Id.). However, one of ordinary skill in the art at the time of the present invention would not have known that Markowitz should have been modified to include the above-referenced features of amended independent claim 27.

Furthermore, claims 44 and 45 have been amended to clarify that the at least one advertisement associated with the identified sending party may be automatically determined at least in part by a demographic of the receiving party (claim 44); and that the demographic may be at least one of location, language, gender, age, income, and physical handicap (claim 45).

The Official Action concedes that Markowitz “failed to explicitly teach that the profile includes demographic data such as gender, age, income, etc.” (page 5, Paper No. 20080516). The Official Action asserts, using official notice, that it is “old and well known in the art at the time of the invention to know that customer profiles include demographic data such as age, income etc, for the intended purpose of providing targeted advertisement based on the demographic data” (pages 5-6, Id.). The Applicant respectfully disagrees and traverses the assertions in the Official Action.

In accordance with MPEP § 2144.03, the Applicant respectfully traverses the above-referenced assertions and request that the Examiner cite references in support of his position or allow the claims. The Applicant respectfully submits that the features of amended claims 44 and 45 are not conventional and would not have been known to one with ordinary skill in the art at the time of the invention.

Since Markowitz does not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

The Official Action rejects claims 36 and 47-49 as obvious based on the combination of Markowitz and U.S. Patent No. 5,105,184 to Pirani. The Applicant respectfully submits that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

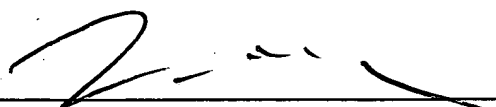
Independent claim 27 has been amended as noted in detail above.

Independent claim 48 has been amended to recite a method of automatically transmitting an advertisement for hardware installed on a data processing system, the advertisement being associated with an identified sending party and transmitted from a sending party to a receiving party comprising the steps of: identifying a user of the data processing system, said identified user being the identified sending party; initiating an e-mail communication from the data processing system of the identified sending party; embedding at least one pre-selected advertisement associated with the identified sending party with the e-mail communication within the data processing system of the identified sending party, wherein the pre-selected advertisement associated with the identified sending party is under the local control of the identified sending party; and transmitting the e-mail communication with the at least one advertisement associated with the identified sending party automatically embedded therein to the receiving party, wherein said advertisement is for hardware installed on the data processing system by said identified sending party.

Please incorporate the arguments above with respect to the deficiencies in Markowitz. Pirani does not cure the deficiencies in Markowitz. The Official Action relies on Pirani to allegedly teach "the advertisement is incorporated in setup software for one of software or hardware and is under local control of the sending party" (page 6, Paper No. 20080516). However, Markowitz and Pirani, either alone or in combination, do not teach or suggest that Markowitz should be modified to include the above-referenced features of amended independent claims 27 and 48. Since Markowitz and Pirani do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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Applicant and Inventor